

REMARKS

Claims 1-20 were examined and reported in the Office Action. Claims 1-20 are rejected. Claim 3 is canceled. Claims 1, 4, 14 and 17 are amended. Claims 1-2 and 4-20 remain.

Applicant requests reconsideration of the application in view of the following remarks.

I. Claim Objections

Claim 3 is objected under 37 CFR §1.75 as being a substantial duplicate of claim 1. Applicant has canceled claim 3. Therefore, the 37 CFR §1.75 objection is now moot.

II. 35 U.S.C. § 103(a)

A. It is asserted in the Office Action that claims 1-3, 5-20 are rejected in the Office Action under 35 U.S.C. § 103(a), as being unpatentable over U. S. Patent No. 5,784,699 issued to McMahon et al. ("McMahon") and Donahue et al. in *Hardware Support for Fast and Bounded-time Storage Allocation*, March 22, 2002 ("Donahue"), and further in view of Albert et al. *Storage Allocation Mechanism for Different Length Data Elements*, April 1, 1975 ("Albert"). Applicant traverses the aforementioned rejection for the following reasons.

According to MPEP §2142

[t]o establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure." (In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)).

Further, according to MPEP §2143.03, "[t]o establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. (In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered

in judging the patentability of that claim against the prior art.” (In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970), emphasis added.)

It is asserted in the Office Action that McMahon and Donahue fail to teach the number of entries of the free list memory is the same as the number of entries of the data memory or that the correspondence between the free list entries and data memory entries is 1:1. We agree. It is then asserted in the Office Action that Albert discloses that the entries of the free list memory and the entries of the data memory have a 1:1 corresponding relationship. This assertion is based on the second and third paragraphs on page 2 of Albert. In Albert, however, the only entries that have a 1:1 ratio are bits in the 16-byte mask and page locations. The bits in the 32-byte mask have a 2:1 correspondence; the bits in the 64-byte mask have a 4:1 correspondence. That is, *all* of the entries in the byte masks do not have a 1:1 correspondence with *all* of the page locations. Thus, Albert requires the use of pointers.

Therefore, even if the teachings of Albert are combined with those of McMahon and Donahue, the resulting invention would still not teach, disclose or suggest the limitations in amended claims 1, 14 and 17 of “the free list memory and the data memory have an equal number of entries and all of the entries of the free list memory and all of the entries of the data memory have a 1:1 corresponding relationship, wherein use of pointers between the entries of the data memory and the entries of the free list memory is unnecessary.”

Since neither McMahon, Donahue, Albert, and therefore, nor the combination of the three, teach, disclose or suggest all the limitations of Applicant's amended claims 1, 14 and 17, Applicant's amended claims 1, 14 and 17 are not obvious over McMahon in view of Donahue and Albert since a *prima facie* case of obviousness has not been met under MPEP §2142. Additionally, the claims that directly or indirectly depend from amended claims 1, 14 and 17, namely claims 2-3, 5-13 and 20, 15-16 and 20, and 18-20, respectively, would also not be obvious over McMahon in view of Donahue and Albert for the same reason.

Accordingly, withdrawal of the 35 U.S.C. § 103(a) rejections for claims 1-3, and 5-20 is respectfully requested.

B. It is asserted in the Office Action that claim 4 is rejected in the Office Action under 35 U.S.C. § 103(a), as being unpatentable over McMahon and Donahue, and further in view of Murdocca et al. ("Murdocca") *Principles of Computer Architecture, 2000*. Applicant traverses the aforementioned rejection for the following reasons.

Applicant's amended claim 4 indirectly depends on amended claim 1. Applicant has addressed claim 1 regarding McMahon and Donahue above in section IA.

As asserted in the Office Action, McMahon and Donahue fail to teach the number of entries of the free list memory is the same as the number of entries of the data memory or that the correspondence between the free list entries and data memory entries is 1:1. Murdocca is relied on for inherently teaching that an address value is calculated. Even if the teachings of Murdocca is combined with those of McMahon and Donahue, the resulting invention would still not teach, disclose or suggest the limitations in amended claims 1, 14 and 17 of "the free list memory and the data memory have an equal number of entries and all of the entries of the free list memory and all of the entries of the data memory have a 1:1 corresponding relationship, wherein use of pointers between the entries of the data memory and the entries of the free list memory is unnecessary."

Since neither McMahon, Donahue, Murdocca, and therefore, nor the combination of the three, teach, disclose or suggest all the limitations of Applicant's amended claim 1, Applicant's amended claim 1 is not obvious over McMahon in view of Donahue and Murdocca since a *prima facie* case of obviousness has not been met under MPEP §2142. Additionally, the claim that directly depends from amended claim 1, namely claim 4, would also not be obvious over McMahon in view of Donahue and Murdocca for the same reason.

Accordingly, withdrawal of the 35 U.S.C. § 103(a) rejection for claim 4 is respectfully requested.

CONCLUSION

In view of the foregoing, it is submitted that claims 1-2 and 4-20 patentably define the subject invention over the cited references of record, and are in condition for allowance and such action is earnestly solicited at the earliest possible date. If the Examiner believes a telephone conference would be useful in moving the case forward, he is encouraged to contact the undersigned at (310) 207-3800.

If necessary, the Commissioner is hereby authorized in this, concurrent and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2666 for any additional fees required under 37 C.F.R. §§1.16 or 1.17, particularly, extension of time fees.

Respectfully submitted,

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CERTIFICATE OF TRANSMISSION

I hereby certify that this correspondence is being submitted electronically via EFS Web on the date shown below to the United States Patent and Trademark Office.


Jean Syoboda

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